

REMARKS

This response is a full and complete response to the Final Office Action, mailed August 29, 2008. In the present Office Action, the Examiner has noted that claims 1-47 are pending and that claims 1-47 stand rejected under 35 U.S.C. §102. By this response, reconsideration of the foregoing claims is respectfully requested.

It is noted that no claims have been amended, cancelled or added. Below each independent claim of the present patent application is discussed.

Claim 1 is directed to "A method for delivering an asset over a network comprising: supplying an asset list over said network to a user device, said user device including a client process; and delivering said asset over said network to said user device if a predetermined constraint is satisfied," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 13 is directed to "A method for presenting to a user content over a network, the method comprising: supplying an asset list over said network to a client process, said client process operating in a user device; delivering an asset, from a remote location, over said network to said user device if a predetermined constraint is satisfied, wherein said asset list comprises at least an indication of said remote location; and integrating the delivered asset with a content stream being received by said user device from said remote

location over said network," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 26 is directed to "A system for presenting content over a network, the system comprising: an asset list capable of being made available by a content provider over the internet to a client process, said client process capable of operating in a user; an asset, made available from a remote location, over said network to said user device if a predetermined constraint is satisfied, wherein said asset list comprises at least an indication of said remote location," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 43 is directed to "A method for presenting a stream of content over a network, the method comprising: supplying an asset list by a content provider over said network to a client process, said client process operating on a user device; delivering an asset, from a remote location, over said network to said user device if a predetermined constraint is satisfied, wherein said asset list comprises at least an indication of said remote location; and integrating the delivered asset with a content stream being received by said user device from said remote location over said network; wherein said asset and said content stream are represented," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 44 is directed to "A system for presenting content over a network the system comprising: an asset list to be made available by a content provider over said network to a

client process, said client process capable of operating in a user device; an asset, to be made available from a remote location, over said network to said user device if a predetermined constraint is satisfied, wherein said asset list comprises at least an indication of said remote location; and an integrator tool for integrating said asset with a content stream being capable of received by said user device from said remote location over said network, wherein said predetermined constraint comprises at least one of at least one of said user device being idle, a bandwidth usage of said network being below a operating level, a time of day, a CPU usage or memory usage of said user device being below operating levels," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 45 is directed to "A method for receiving an asset over a network comprising: receiving an asset list provided by a content provider over said network at a client, said client operating in a user device; and receiving said asset, corresponding to at least a portion of said asset list, over said network at user device if a predetermined constraint is satisfied; wherein said predetermined constraint comprises at least one of said user device being idle, a network Quality of Service (QOS), a network bandwidth usage being below an operating level, a CPU usage or memory usage of said user device being below operating levels," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], and/or Figs. 1 and/or 2, for example.

Claim 46 is directed to "A method for providing a home media library to a user over a network, the method comprising: supplying an asset list by a content provider over said

network to a set-top box, said set-top box comprising a client process capable of managing delivery of assets; and delivering an asset, from a remote location, over said network to said set-top box if a predetermined constraint is satisfied, as indicated by said client process wherein said asset list comprises at least an indication of said remote location," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], paragraph [0076] to [0078] and/or Figs. 1 and/or 2, for example.

Claim 47 is directed to "A method of receiving media assets at a set-top box for storage and subsequent viewing, the method comprising: receiving a media asset list from a content provider on said set top box, said media asset list comprising a list of media assets to be downloaded and information about the location of the media assets; running a client process on said set top box, wherein said client process is capable of reading said media asset list to determine what media assets to transfer to the set top box, and wherein said client process is further capable of managing delivery of digital media assets based at least in part on predetermined constraints; downloading digital media assets from said content provider to said set top box if said predetermined constraints are satisfied; and storing the downloaded digital media assets on said set top box for subsequent viewing on a television or other display device," see specification paragraphs [0034] to [0039], paragraph [0055], paragraph [0061], paragraph [0076] to [0078] and/or Figs. 1 and/or 2, for example.

In the Final Office Action, claims 1-47 were rejected under 35 USC § 102 as being anticipated by US Patent No. 6, 442,285 to Rhoads et al. (hereinafter "Rhoads"). In response, Assignee respectfully traverses the basis of such rejection. For at least the reasons set forth below, Assignee submits that claims 1-47 are not anticipated by Rhoads.

The Examiner is reminded that the Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. V. Union Oil Co. California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document.

It is respectfully asserted that Rhoads does not show or describe each and every element or limitation of the foregoing claims. Therefore, the Examiner has failed to successfully make a *prima facie* case of anticipation.

A close reading of Rhoads makes clear that it is not directed to supplying an asset list. The Examiner disputes this position in paragraph 2 on page 2 of the Final Office Action referenced above. However, none of the examples provided by the Examiner involve supplying an asset list over a network to a user device.

For example, the Examiner points to Col. 9, lines 7-9; however, this portion of Rhoads refers to a single asset, not an asset list. It is indicated that a user may use a device to identify the last several selections ***that have been played***, but that is not providing an asset list. The Examiner also points to Col. 9, lines 18-20; however, again, it is clear from the discussion in Rhoads that ***a single asset***, such as a song, is identified by the memory. The Examiner also points to Col. 8, lines 50-65. Here, this portion of the document refers to a personal library ***maintained by the user***. Therefore, this could not meet the limitation of supplying as asset list to a user device. The last portion of Rhoads pointed to the Examiner, Col. 25, line 50, to Col. 26, line 7, was discussed in the prior response and is further discussed below to demonstrate that it to does not show or describe providing an asset list.

Specifically, Rhoads at column 25, lines 51-53, states: "Consider an application program or other client process that receives ***a watermarked media object***. The watermark includes an MGA for that object...Stored at the MGA site is meta-data corresponding to ***the object***...." Likewise, at column 4, lines 59-62: "...the payload can include a digital object identifier – an ISBN-like number issued by a central organization (e.g. a rights management organization) to uniquely identify ***the work***." Rhoads, at the top of column 5, goes on to describe a Master Global Address (MGA); however, again, MGAs appear to be directed to ***individual objects or assets*** – not to a list of assets. Therefore, it is apparent that the subject matter of Rhoads is not directed to supplying a list of assets to a user device or the like.

Here, to be specific, the Examiner has rejected claim 1 under section 102 asserting that Rhoads shows or discloses the claim language "supplying an asset list over said network to a user device, said user device including a client process," as recited by claim 1. It is Assignee's position that the Examiner is incorrect and that Rhoads does not disclose "supplying an asset list over said network to a user device, said user device including a client process." The Examiner contends that this aspect of Assignee's claimed subject matter is taught by the portions of Rhoads discussed above. Assignee respectfully disagrees with this assertion and believes that the discussion above of the specific portions of Rhoads relied upon clarifies that the Examiner is misinterpreting Rhoads.

Assignee respectfully asserts that these portions do not show anything relating to an asset list. Assignee respectfully asserts, therefore, that it is clear from the portions of Rhoads discussed above that this document does not show "supplying an asset list over said network to a user device, said user device including a client process," as recited by Assignee's claim 1. In fact, Rhoads does not appear to relate at all to the subject matter recited in claim 1 and Assignee continues to be puzzled why it is being cited as anticipatory of claim 1, for example. As the quote from Col. 25, lines 51-53 above demonstrates, ***Rhoads appears to be specifically directed to watermarking a media object***, which is a subject that is different than the focus of the current specification.

While claimed subject matter is, of course, not limited by the specification, illustrative examples from the present application may also be useful for demonstrating that Rhoads

does not appear to relate to subject matter of the present patent application. For example, paragraph [0034] of the present application states that “[a]n asset list comprises information related to the media assets to be downloaded to the client device.” Further, paragraph [0055] of the present application states that “[i]n one implementation, the assets included in the cache are dictated by an asset list provided by a content provider.” Likewise, paragraph [0056] of the present application states that “[a] client is allowed to be associated with more than one asset list, so that many service providers or multiple business units of one service provider can separately maintain their own asset lists and make use of the same client to manage the downloads.” Assignee respectfully asserts that Rhoads, including those portions identified by the Examiner, therefore does not show “supplying an asset list over said network to a user device, said user device including a client process,” as recited by Assignee’s claim 1. However, again, it should be noted that the above examples are provided for illustrative purposes only and that claimed subject matter is, of course, not limited to the examples provided.

Thus, Rhoads does not appear to be even directed to the problem addressed by Assignee’s claimed subject matter. Given the differences between the subject matter of Rhoads and Assignee’s claimed subject matter, using claim 1, for example, as an illustration, it is again respectfully asserted that the Examiner has misconstrued Rhoads. Assignee respectfully asserts that Rhoads does not show anything related to Assignee’s claimed subject matter regarding supplying an asset list over a network. In light of this, it is respectfully asserted that the Examiner’s rejection of claim 1, as an illustrative example,

has been traversed. It is, therefore, respectfully requested that the Examiner's rejection of claim 1 on this ground be withdrawn.

However, the same point may be made with respect to the other independent claims (and, therefore, their dependent claims). For example, Claim 13 also recites "supplying an asset list over said network to a client process, said client process operating in a user device." Likewise, Claim 26 recites: "an asset list capable of being made available by a content provider over the internet to a client process, said client process capable of operating in a user device." Claim 43 recites: "supplying an asset list by a content provider over said network to a client process, said client process operating on a user device." Claim 44 recites: "an asset list to be made available by a content provider over said network to a client process, said client process capable of operating in a user device." Claim 45 recites: "receiving an asset list provided by a content provider over said network at a client, said client operating in a user device." Claim 46 recites "supplying an asset list by a content provider over said network to a set-top box, said set-top box comprising a client process capable of managing deliver of assets." Claim 47 recites: "receiving a media asset list from a content provider on said set top box, said media asset list comprising a list of media assets to be downloaded and information about the location of the media assets." In light of this, it is respectfully asserted that the Examiner's rejection of all the claims of the present application has been traversed. It is, therefore, respectfully requested that the Examiner's rejection of these claims on this ground be withdrawn.

While it is believed that the rejected claims could be distinguished from Rhoads on additional bases, it is so clear that Rhoads does not meet any of the limitations recited above; Assignee does not feel that it is necessary to point out other distinctions between Rhoads and the rejected claims. Likewise, because the independent claims all distinguish from Rhoads on the basis discussed above, likewise, the claims that depend from the independent claims also distinguish from Rhoads on at least the same basis.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Assignee does not agree in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

The foregoing is submitted as a full and complete response to the Final Office Action, mailed August 29, 2008. In view of the foregoing amendment and remarks, Assignee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3130.

Respectfully submitted,

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